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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/759,165	01/16/2001	Veronique Douin	05725.0827-00000	9808
22852	7590	06/19/2009		
FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP 901 NEW YORK AVENUE, NW WASHINGTON, DC 20001-4413			EXAMINER WANG, SHENGJUN	
			ART UNIT	PAPER NUMBER
			1617	
			MAIL DATE	DELIVERY MODE
			06/19/2009 PAPER	

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/759,165

Applicant(s)

DOUIN ET AL.

Examiner

Shengjun Wang

Art Unit

1617

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 April 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 25, 28, 38, 39 and 43-58 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 25, 28, 38, 39 and 43-58 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/C)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Mail Date _____

DETAILED ACTION

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on April 8, 2009 has been entered.

Claim Rejections - 35 U.S.C. 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 25, 28, 38, 39, and 43-58 rejected under 35 U.S.C. 103(a) as being unpatentable over Sweger et al. (US patent 5,482,704, or record), in view of Matsumoto et al. (U.S. Patent 6,010,689) and Uchiyama et al. (US Patent 5,876,705).

Sweger teaches a hair compositions containing amino-multicarboxylate modified starch. See the claims. Example 1 illustrates a starch modified with 2-chloroethylaminodipropionic acid (CEPA) (see col. 6, line 44 through col. 7, line 10). The starch derivatives provide thickening and emulsion stabilization and exhibit good appearance and feel to the skin (see col. 1, lines 32-37, col. 9, lines 60-63). The reference teaches that polyacrylic acid polymers such as Carbopol resins are the leading thickeners and emulsion stabilizers in the

skin care and hair care markets. The reference further teaches that CEPA-modified starch gives stable viscosity over time and is superior to the Carbopol® standard (see col. 9, lines 1-6).

Sweger does not teach expressly the other ingredients in the hair composition, such as conditioning agent behenyltrimethylammonium, or anionic surfactant alkyl ether sulfate. However, it would have been prima facie obvious to a person of ordinary skill in the art, at the time the claimed the invention was made, to use hair conditioning agents, and surfactants because those are well known essential ingredients normally used for hair compositions. For example, Matsumoto et al. teaches that behenyltrimethylammonium is a well-known hair conditioning agent, and alkyl ether sulfate are anionic surfactant known to be useful in hair composition. See, particularly, column 2, line 13 to column 3, line 36, column 5, lines 28-50, and column 7, lines 13-65. Uchiyama et al. teaches that a conditioning shampoo composition may comprise anionic surfactant, conditioning agent, such as behenyltrimethylammonium and thickener. See, particularly, the claims, and column 22, lines 34-55. Further, The optimization of a result effective parameter, e.g., optimal amounts of each known ingredients in a cosmetic composition, or a proper pH, is considered within the skill of the artisan. See, In re Boesch and Slaney (CCPA) 204 USPQ 215.

3. Claims 1, 25, 28, 38, 39, and 43-58 are rejected under 35 U.S.C. 103(a) as being unpatentable over Janchipraponvej (US Pat. 4,954,335) in view of Sweger et al (US Pat. 5,482,704) and Martino et al (US Pat. 6,210,689) and in further view of Uchiyama et al.

Janchipraponvej teaches clear conditioning compositions and methods to impart improved properties to hair. The compositions provide excellent wet comb and dry comb properties to the hair, and the hair demonstrates improved physical and cosmetic properties (see

col. 7, lines 21-48). The compositions of Janchipraponvej contain quaternary ammonium compounds (see col. 8, line 8-47). Behenyltrimethylammonium chloride is specifically taught (see col. 10, lines 1-29). Weight percentages of the quaternary ammonium compound are taught (see col. 10, lines 30-45). The reference teaches the use of thickening agents such as polyacrylic acid derivatives, and that the resulting compositions are relatively viscous compositions that are stable to phase separation for an indefinite period of time (see col. 16, lines 9-32). A preferred range of pH from 5.5 to 6.5 is taught (see col. 14, lines 5-18). Additional surfactants are included in the composition (see col. 14, line 19 through col. 15, line 18). The reference lacks modified starch and anionic surfactants.

Sweger teaches cosmetic compositions containing amino-multicarboxylate modified starch. Example 1 illustrates a starch modified with z-chloroethylaminodipropionic acid (CEPA) (see col. 6, line 44 through col. 7, line 10). The starch derivatives provide thickening and emulsion stabilization and exhibit good appearance and feel to the skin (see col. 1, lines 32-37., col. 9, lines 60-63). The reference teaches that polyacrylic acid polymers such as Carbopol resins are the leading thickeners and emulsion stabilizers in the skin care and hair care markets. The reference further teaches that CEPA-modified starch gives stable viscosity over time and is superior to the Carbopol® standard (see col. 9, lines 1-6). Sweger et al. further teaches that the CEPA-modified starch may be used together with other ionic or non-ionic surfactants. See, particularly, col. 4, line 39 to col. 5, line 13.

Martino teaches the use of alkyl ether sulfate salts as well know surfactants in cosmetic formulations (see col. 5, lines 1 1-26). The reference teaches that certain alkyl ether sulfate salts are particularly useful in combination with keratin treating cosmetic compositions containing

amphoteric starch derivatives as disclosed in the reference (see abstract and col. 5, lines 16-17). Uchiyama et al. teaches that a conditioning shampoo composition may comprise anionic surfactant, conditioning agent, such as behenyltrimethylammonium and thickener. See, particularly, the claims, and column 22, lines 34-55.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the compositions of Janchipraponvej by the addition of amphoteric starches as taught by Sweger and anionic surfactants as taught by Martino in order to benefit from the improved results of the amphoteric starches with respect to viscosity and thickening as taught by Sweger.

Response to the Arguments

4. Applicants' amendments, remarks and the declaration under 37 C.F.R. 1.132 have been fully considered, but are not persuasive.
5. The declaration under 37 CFR 1.132 filed April 8, 2009 is insufficient to overcome the rejection of claims 1, 25, 28, 38, 39, and 43-58 based upon Sweger et al., Matsumoto et al., and Uchiyama et al., or based upon Janchipraponvej, Sweger et al., Martino et al, and Uchiyama et al. as set forth in the last Office action because: a prima facie case of unexpected benefit residing in the claimed invention, wherein the unexpected results are practically and statistically significant, has not been established. Regarding the establishment of unexpected results, a few notable principles are well settled. It is applicant's burden to explain any proffered data and establish how any results therein should be taken to be unexpected and significant. See MPEP 716.02 (b). The claims must be commensurate in the scope with any evidence of unexpected results. See MPEP 716.02 (d). Further, A DECLARATION UNDER 37 CFR 1.132 must

compare the claimed subject matter with the closest prior art in order to be effective to rebut a prima facie case of obviousness. See, MPEP 716.02 (e). In instant case, the declaration compares the combination of CEPA (a polymer) with three known commercial conditioners: Jaguar C13S (cationic guar gum, a polymeric material), Genamin KDMF (Behenyltrimethyl ammonium chloride, invention), Varisoft W 575 PG (methyl alkyl alkylamidoethyl imidazolium methysulfate-quaternium-87, invention), and SME 253 (particularly known as detangler?) in the aspect for detangle. The declaration provide no further explanation as to what are known for those agents other than as conditioning agents generally and why are the results unexpected. It is known that hair conditioning encompasses many aspects, detangling is only one of them. See, wikipedia attached herewith. Further, one of ordinary skill in the art would have selected Genamin KDMF (Behenyltrimethyl ammonium chloride) over Jaguar C13S for use with CEPA since Jaguar is used as thickening and conditioning agent (see Jagaur C13S), and CEPA is known s thickening agent, one of ordinary skill I the art would not motivated to add another thickener. Furthermore, behenyl trimethyl ammonium chloride is a known antistatic agent, the improvement of disentangling property would have reasonably expected. See, Genamin KDMF. In view of the foregoing, when all of the evidence is considered, the totality of the rebuttal evidence of nonobviousness fails to outweigh the evidence of obviousness.

6. Applicants' remarks regarding there ejections over Sweger et al. (US patent 5,482,704, or record), in view of Matsumoto et al. (U.S. Patent 6,010,689) and Uchiyama et al. (US Patent 5,876,705) are not persuasive for reasons discussed above. Further, since the cationic compounds

herein are known hair conditioning agents, the employment of these agents as conditioning agents in a hair care products would have been obvious. "[W]hen a patent claims a structure already known in the prior art that is altered by the mere substitution of one element for another known in the field, the combination must do more than yield a predictable result." *KSR Int'l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1740 (2007). Applicants fails presented such evidence that

7. Applicants' attention is further directed to *KSR vs. Teleflex*, where the court states:

"When there is a design need or market pressure to solve a problem and there are a finite number of identified, predictable solutions, a person of ordinary skill has good reason to pursue the known options within his or her technical grasp. **If this leads to the anticipated success, it is likely the product not of innovation but of ordinary skill and common sense.** In that instance the fact that a combination was obvious to try might show it was obvious under section 103." In the instant case, the hair conditioning agents herein are old and well-known commercial products. One of ordinary skill in the art would have reasonably anticipated the success of the employment of them as hair conditioning agents.

8. Applicant's arguments regarding the rejections over Janchipraponvej (US Pat. 4,954,335) in view of Sweger et al (US Pat. 5,482,704) and Martino et al (US Pat. 6,210,689) and in further view of Uchiyama et al. are not probative for reasons discussed below:

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). The cited references teach that each and every ingredient herein is known for the function herein claimed, e.g., thickener, hair

conditioning agent, surfactant, etc. . It is also known that a hair care product contains surfactant(s), thickener, hair conditioning agent. "[W]hen a patent claims a structure already known in the prior art that is altered by the mere substitution of one element for another known in the field, the combination must do more than yield a predictable result." *KSR Int'l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1740 (2007). As discussed above, applicant fails to present a prima facie case of unexpected results. The Alleged "teach away" is not persuasive for reasons discussed on the record. Particularly,

Applicant generated data, proffered to obviate prior art teachings, lacks the probative force accorded data generated by independent, disinterested parties. It is well settled patent law "that it is not a difficult matter to carry out a process in such a fashion that it will not be successful and, therefore, the failures of experimenters who have no interest in succeeding should not be accorded great weight" In re Michalek, 74 USPQ 108, at 109 citing Bullard Company et al v. Coe, 147 F.2d. 568, 64 USPQ 359.

Further, one of ordinary skill in the art would have not expected that CEPA carbomer have identical properties, including solubility. Therefore, the detailed procedure for making CEPA solution would not be the same as those for carbomer. See the examples in Sweger et al.

Further, disclosed examples and preferred embodiments do not constitute a teaching away from a broader disclosure or nonpreferred embodiments. In re Susi, 440 F.2d 442, 169 USPQ 423 (CCPA 1971). Sweger et al. teach CEPA as thickener, it would have been obvious to use CEPA as a thickener in cosmetic composition, whether the composition is emulsion or non-emulsion.

9. The references listed in the form 892, but not cited in this action, are considered relevant to the claimed subject matter.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shengjun Wang whose telephone number is (571) 272-0632. The examiner can normally be reached on Monday to Friday from 7:00 am to 3:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreeni Padmanabhan, can be reached on (571) 272-0629. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Shengjun Wang/
Primary Examiner, Art Unit 1617

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